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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/538,458	06/10/2005	Lonnie Goff	US02 0598 US2	3872
65913	7550	12/12/2008	EXAMINER	
NXP, B.V. NXP INTELLECTUAL PROPERTY DEPARTMENT M/S41-SJ 1109 MCKAY DRIVE SAN JOSE, CA 95131			MAMO, ELIAS	
			ART UNIT	PAPER NUMBER
			2184	
			NOTIFICATION DATE	DELIVERY MODE
			12/12/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ip.department.us@nxp.com

Office Action Summary

Application No.

10/538,458

Applicant(s)

GOFF, LONNIE

Examiner

ELIAS MAMO

Art Unit

2184

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CIS)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

In view of the Appeal Brief filed on 04/10/2008 **PROSECUTION IS HEREBY REOPENED**. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4, 5, 9, 10 and 11-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 4, 5, 9, 10 and 11 recite a term "configuration/control ID" which is not defined and it is confusing. For the purpose of examining the current application it is construed as "configuration initialization" or "control command".

Use of the acronym "ID" in claims 4, 5, 9, 10 and 11 fails to particularly point out and distinctly claim the subject matter. At least, it should be spelled out first time it appears in the claims. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-12 rejected under 35 U.S.C. 102(b) as being anticipated by Uppunda et al. (US 6,640,262), herein after referred to as Uppunda et al. '262.

Referring to **claim 1**, Uppunda et al. '262 teaches, as claimed, a method of performing configuration or control of a subsystem (i.e.-a method for configuring a network interface, col. 2, lines 19-20) comprising:

-providing together with the subsystem a configuration/control unit having a controller portion and a storage portion storing configuration parameters registers (i.e.-ASIC 202 and EEPROM 204 form a configuration unit, see fig. 2 and col. 3, lines 12-13); the configuration/control unit receiving an activation signal (Note: receiving activation signal upon initialization of the system) and the configuration/control unit, in response to the activation signal, performing configuration or control of the subsystem, including storing at least one of the configuration parameters in a register of the

subsystem (i.e.-after the initialization, the ASIC 202 loads the configuration data, from the EEPROM 204, col. 3, lines 48-50).

As to **claim 2**, Uppunda et al. '262 teaches the method of claim 1 wherein the subsystem is a hardware subsystem (i.e.-NIC 106, see fig. 1), and the configuration/control unit is a hardware configuration/control unit (i.e.-ASIC 202, fig. 1).

As to **claim 3**, Uppunda et al. '262 teaches the method of claim 1 wherein the hardware subsystem and the hardware configuration/control unit are provided together within the same integrated circuit (i.e.-NIC 106, see fig. 1).

As to **claim 4**, Uppunda et al. '262 teaches the method of claim 1 wherein the activation signal is a configuration/control ID (Note: initialization step/process, col. 3, line 48-49).

As to **claim 5**, Uppunda et al. '262 teaches the method of claim 4 wherein the configuration/control unit is responsive to multiple different configuration/control IDs for performing different corresponding configuration or control actions with respect to the subsystem (col. 4, lines 20-35).

Referring to **claim 6**, Uppunda et al. '262 teaches, as claimed, a subsystem having self-configuration capabilities (i.e.-NIC 106 having ASIC 202, see fig. 1 and col. 3, lines 31-33), comprising: a register section including multiple registers (i.e.-ASIC 202, see fig. 1

and col. 3, lines 34-35), the subsystem functioning differently depending on contents of the registers; and a configuration/control unit having a controller portion and a storage portion storing configuration parameter registers (i.e.-ASIC 202 and EEPROM 204 form a configuration unit, see fig. 2); wherein the configuration/control unit is responsive to an activation signal for performing configuration or control of the subsystem, including storing at least one of the configuration parameter in one of the multiple registers of the subsystem (i.e.-after the initialization, the ASIC 202 loads the configuration data, from the EEPROM 204, col. 3, lines 48-50).

As to **claim 7**, Uppunda et al. '262 teaches the apparatus of claim 6 wherein subsystem is a hardware subsystem, and the configuration/control unit is a hardware configuration/control unit.

As to **claim 8**, Uppunda et al. '262 teaches the apparatus of claim 7 wherein the hardware subsystem and the hardware configuration/control unit are provided together within the same integrated circuit.

As to **claim 9**, Uppunda et al. '262 teaches the apparatus of claim 6 wherein the activation signal is a configuration/control ID.

As to **claim 10**, Uppunda et al. '262 teaches the apparatus of claim 9 wherein the configuration/ control unit is responsive to multiple different configuration/control IDs for

performing different corresponding configuration or control actions with respect to the subsystem.

Referring to **claim 11**, Uppunda et al. '262 teaches, as claimed, for use in a system that includes a processor coupled to a hardware subsystem via a system bus (see fig. 1), the hardware subsystem (i.e.-NIC 106, fig. 1) including a configuration/control unit and a plurality of registers (i.e.-ASIC 202 and EEPROM 204 form a configuration unit, see fig. 2), a method of configuring the subsystem (i.e.-a method for configuring a network interface, col. 2, lines 19-20) comprising: storing a configuration parameter in the configuration/control unit (Note: EEPROM is loaded with commands and data, col. 2, lines 23-25); and responsive to the configuration/control unit receiving a single configuration/ control ID from the processor (Note: receiving activation signal upon initialization of the system), writing one or more of the plurality of configuration parameters from the configuration/control unit to one or more of the plurality of registers (i.e.-after the initialization, the ASIC 202 loads the configuration data, from the EEPROM 204, col. 3, lines 48-50).

As to **claim 12**, Uppunda et al. '262 teaches the method of claim 11, wherein the configuration/control unit is a state machine (see fig. 4).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Uppunda et al. '262 in view of Wu et al. (US 6,862,643), herein after referred to as Wu et al. '643.

As to **claim 13**, Uppunda et al. '262 teaches the claimed invention except claim 13.

On the other hand, Wu et al. '643 discloses, a USB block comprising a plurality of ports (see fig. 5) that can operate in different modes responsive to which of the plurality of configuration parameters are written to which of the plurality of registers (page 2, paragraph 23).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to modify the hardware subsystem of Uppunda et al. '262 and implement it in the USB block which comprises a plurality of ports that can operate in different modes responsive to which of the plurality of configuration parameters are written to which of the plurality of registers, as taught by Wu et al. '643. The motivation for doing so would have been to use one compound device in which a plurality of function devices can connect to the USB via the same set of USB logic, with out using a hub but a circuit

or firmware, achieving a convenience of plug and play while reducing a cost (Wu et al., page 2, paragraph 19 and 21).

Response to Arguments

Applicant's arguments filed on 09/23/2008 have been fully considered but are moot in view of the new grounds of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Madurawe (US 7,064,579) teaches alterable application specific integrated circuit;
- Ptasinski et al. (US 6,363,437) teach plug and play I²C slave; and
- Takahashi et al. (US 5,887,193) teach system for loading control information from peripheral devices to a controller in response to connection operation.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elias Mamo whose telephone number is (571) 270-1726 and fax number (571) 270-2726. The examiner can normally be reached on Monday to Thursday from 9 AM to 5 PM EST. The examiner can also be reached on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, DR. Henry Tsai, can be reached on (571) 272-4176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/E. M./

Examiner, Art Unit 2184

**/Henry W.H. Tsai/
Supervisory Patent Examiner, Art Unit 2184**